



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

08/932,227

09/17/1997

ERIC T. FOSSEL

5092

23628

7590

06/05/2006

WOLF GREENFIELD & SACKS, PC
FEDERAL RESERVE PLAZA
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

EXAMINER

MULLIS, JEFFREY C

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/932,227

Applicant(s)

FOSSEL, ERIC T.

Examiner

Jeffrey C. Mullis

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-35,38-44,47-53,56-59,61-67,69,70 and 72-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-35,38-44,47-53,56-59,61-67,69,70 and 72-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3-13-06; 4-14-06; 4-10-06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1711

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 64 is rejected under 35 U.S.C. 102(a) as anticipated by Saavedra et al. (US 5,632,981).

See the Office action of 9-8-05 at the penultimate paragraph on page 2.

Claims 65 and 66 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Saavedra, cited above.

See the Office action of 9-8-05 at page 3, lines 1 et seq.

Claims 33, 34, 64 and 70-73 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Biurope Societe (FR 2,740,453).

See the Office action of 9-8-05 at the fourth paragraph et seq.

Art Unit: 1711

Claims 33-35, 38, 64-67, 69, 70, 72 and 73 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gibson (US 4,871,839).

Note Example 13 of the patent discloses use of a hair regrowth composition containing Minoxidil and sodium chloride. Note Whitmore, newly cited by applicants at the paragraph bridging columns 52 and 53 which discloses that Minoxidil increases bloodflow in the scalp and also note Birder (CAPLUS AN:1998:548084) as well as Shahinpoor (US 2002/0168424) who discloses that Minoxidil (as well as nitroglycerine, capsaicin, isosorbide dinitrate and nitroprusside) are NO donors.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Claims 33-35, 38, 70, 72 and 73 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brand (US 4,681,897).

Brand discloses a composition containing capsaicin (abstract) as saline

Art Unit: 1711

Or other substances such as hydrophobic materials disclosed by applicants specification as creating a hostile biophysical environment. Note also that applicant's specification discloses that capsaicin itself creates a hostile biophysical environment.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Claims 33-35, 38-44, 47-53, 56-59, 61-67 and 69-81 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/201635. Although the conflicting claims are not identical, they are not patentably distinct from each other because the salts recited by the copending application are disclosed by the instant application to inherently act to produce a hostile biophysical environment and such would therefore be inherent in the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 1711

Applicant's arguments filed 3-13-06 have been fully considered but they are not persuasive. With re to Saavedra, as set out in the above rejection, patentees disclose the use of "saline", i.e. sodium chloride as required by the instant claims.

Biurope Societe discloses use of applicants sodium chloride in the examples on page 4.

The terminal disclaimer filed on 3-13-06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 5,895,658 has been reviewed and is accepted. The terminal disclaimer has been recorded.

The terminal disclaimer filed on 3-13-06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6,458,841 has been reviewed and is accepted. The terminal disclaimer has been recorded.

The terminal disclaimer filed on 3-13-06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 5,922,332 has been reviewed and is accepted. The terminal disclaimer has been recorded.

The terminal disclaimer filed on 6-14-05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,207,713 has been reviewed and is accepted. The terminal disclaimer has been recorded.

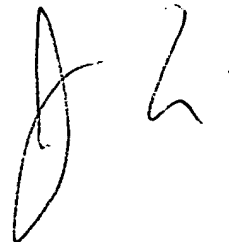
Art Unit: 1711

Any inquiry concerning this communication should be directed to Jeffrey
C. Mullis at telephone number 571 272 1075.

Jeffrey C. Mullis
J Mullis
Art Unit 1711

JCM

5-7-06

A handwritten signature in black ink, appearing to be 'J. Mullis', written in a cursive style.

Jeffrey Mullis
Primary Examiner
Art Unit 1711

A handwritten signature in black ink, appearing to be 'J. Mullis', written in a cursive style, located below the printed name.